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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,341	03/12/2004	Marc Husemann	tesa 1605-WCG	9929
27386	7590	12/29/2004	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A.			HUANG, MEI QI	
875 THIRD AVE			ART UNIT	
18TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10022			1713	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/800,341

Applicant(s)

HUSEMANN ET AL.

Examiner

Mei Q. Huang

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on Mar 12 04, Jun 25 04, Jul 29 04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to a hotmelt pressure sensitive adhesive composition, classified in class 524, subclass 560.
  - II. Claims 18-21, drawn to a process for preparing the hotmelt pressure sensitive adhesive, classified in class 524, subclass 425.
  - III. Claims 22-29, drawn to an adhesive tape coating with the composition of Group I, classified in class 428, subclass 355 AC.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as emulsion polymerization employing ionic emulsifiers.
3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product (MPEP § 806.05(h)). In the instant case, the adhesive can be applied to labels or directly onto two substrates at the time of affixing.

4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Whereas invention II relates to a process for preparing a hotmelt pressure sensitive adhesive, invention III relates to an adhesive tap coated with the composition of Group I. Clearly, the two inventions have different functions and different effects. The process of invention II can not be used to make the article of invention III. As such, they are unrelated. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as show by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed invention: various polymers as described in Claims 1-15.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 11 and 14 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1713

9. During a telephone conversation with Attorney, Mr. William C. Gerstenzang, on December 21, 2004 a provisional election was made with traverse to prosecute the invention of Group I wherein the elected species is polyacrylate which is formed from at least one acrylate monomer, claims 1-9, 16 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-15 and 18-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

11. Claim 2 is objected to because of the following informalities: "average molar weight,  $M_w$ " should be changed to "weight-average molecular weight,  $M_w$ ". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1713

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention with the phrase "is substantially free from polar groups" in the claim language.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1, 3-9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025).

The prior art to Massow et al. provides an acrylate-based hotmelt pressure sensitive adhesive comprising 55 to 98% by weight of acrylic alkyl ester (column 3, line

Art Unit: 1713

42-46) wherein the general formula of alkyl esters of acrylic acid or methacrylic acid is identical to that indicated in Claim 1 (column 3, line 28-40, It is noted that the general formula in the prior art is wrong and it should be  $\text{CH}_2=\text{C}(\text{R})-\text{COOR}'$ ) and Massow et al.'s description for the acrylate alkyl ester appears to read on the polyacrylate component limitations in applicant's claims 1 and 6-9. Massow et al. further disclose that the adhesive composition can contain additives and auxiliaries, such as antioxidants, sensitizers for UV crosslinking, fillers (for example 0.1 – 50%), resins or resin systems (column 4, line 36-41).

The difference between the prior art and the present invention is that even though Massow et al. disclose the amounts of the additives but do not specify the species for the additives used in their adhesive composition, for example, fillers.

The prior art to Guldbrandsen et al. disclose the additives that are used in their invented hotmelt pressure sensitive adhesive formulation such as, aging inhibitors, crosslinkers, plasticizers, accelerators (column 4, line 25-28) as required by claim 17. Guldbrandsen et al. also teach that their adhesive composition may have included fillers such as chalk (column 4, line 29-31), as required by claims 1, 3 and 4. Moreover, Guldbrandsen et al. disclose that their adhesive composition includes tackifier resins such as, the resins made of the rosins, aliphatic and aromatic hydrocarbon resins (column 4, line 56-64), as required by claim 16.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the species of the additives, as taught by



Guldbrandsen et al., into Massow et al.'s adhesive composition in order to adjust and improve the properties of the resultant adhesive composition.

With regard to claim 5, as discussed above, the adhesive composition prepared by Massow et al. is substantially identical to the claimed composition. Therefore, it is the examiner's position to believe that the prior art composition must inherently possess the same shrinkback, as indicated in claim 5. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to the applicant to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1).

The references to Massow et al. and Guldbrandsen et al. are adequately presented in paragraph 16 above and is incorporated herein by reference.

The difference between the references and the present invention is that, even though Massow et al. include regulators during the polymerization (column 5, line 7-8), Massow et al. do not disclose the weight-average molecular weight of the polyacrylate product. However, the  $M_w$  of polyacrylate less than 500,000 is well known such as taught by Lai. The prior art to Lai discloses weight-average molecular weight of polyacrylate products less than 500,000 (Example 4-9, paragraph [0195-0214]) by using various chain transfer agents in the acrylate polymerization process. Therefore, it would

Art Unit: 1713

be obvious for Massow et al. reference to obtain polyacrylate with a  $M_w$  less than 500,000 because similar chain transfer agent is used for both situations.

### ***Priority***

18. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on March 18, 2003. It is noted, however, that applicant has not filed a certified copy of the 103 12 062.9 application as required by 35 U.S.C. 119(b).

### ***Conclusion***

The prior art made of record but not relied upon is considered pertinent to applicant's disclosure. The following references have been cited to show the state of the art with respect to the study of acrylate-based hotmelt pressure sensitive adhesive.

U.S. Pub No. 2004/0047985 to Storbeck et al.

U.S. Pub. No. 2004/0180118 to Renger et al.

U.S. Pub. No. 2004/0024111 to Husemann et al.

U.S. Pub. No. 2004/0168517 to Husemann et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mei Q. Huang whose telephone number is (571) 272-3549. The examiner can normally be reached on 8am - 4pm, Mon. - Fri..

Art Unit: 1713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mei Q. Huang  
Patent Examiner

December 23, 2004



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